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EXAMINER

BUI, LUAN KIM

ART UNIT PAPER NUMBER

3728

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,147

Applicant(s)

COOPER ET AL.

Examiner

Luan K Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 7-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-10,12-18,20,21,23-29 and 31-33 is/are rejected.
- 7) ☒ Claim(s) 11,19,22,30 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

1. As a point of clarification, claim 14 should be depended on claim 13 instead of claim 1 since claim 15 depends on claim 14 and recites "a second finger member". There is no such finger member in claim 1 except for claim 13.

Drawings

2. The correction drawings (Figure 2) were received on 9/25/2003. These drawings are approved by the Examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 27, 29, 31 and 32 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Karay (949,485). Karay discloses a storage container comprising a base (A) having at least one pocket/receiving member (h) and a cover (A') pivotally coupled with the base and having a storage ledge pivotally coupled with the cover. The storage ledge pivoting between a first position wherein the ledge is substantially parallel to the cover in a non-tool retaining position (Figure 7) to a second position wherein the ledge is substantially perpendicular to the cover (Figure 2) in a tool retaining position. The pocket of Karay is inherently capable of receiving a tool and the second position of the ledge is capable of retaining a tool where the tool passes through the ledge and is maintained perpendicular to the ledge by using the tool to pierce through

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the ledge. As to claim 29, Karay further discloses a handle (722) and the handle is capable to be mounted on a vertical surface. As to claims 31 and 32, Karay also discloses the base having at least a second pocket/storage area and the cover including a pocket/storage area (h').

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 7-9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (6,415,923) in view of Vasudeva (6,044,973) and Ling (6,523,687). Chen discloses a tool storage container comprising a base member (10), a cover (20) pivotally coupled with the base member, a tool receiving member (17) disposed in the base and an opening (24) in the cover having a shape corresponding to the tool in the tool receiving member and enabling viewing of the tool positioned in the base with a desired size that prohibits removal of the tool through the cover when the cover and base are coupled together (Figures 1-5). Chen also discloses the other claimed limitations except for the tool receiving member comprises an outline of the tool to be received in the tool receiving member, a transparent window covering the opening and a mechanism in the base for enabling the base to be mounted on a vertical surface. Vasudeva shows a tool storage container comprising a base member (1, 10, 12) and a cover (2) pivotally coupled to the base. The base having a tool receiving member (10, 12) defining an outline of the tool to be received (Figure 8 and column 3, lines 41-48) and a mechanism (11) for enabling the

base to be mounted on a vertical surface. Ling shows a tool storage container comprising a base member (20b), a cover (20a), an opening (24) in the cover and a transparent window (25) covering the opening to enable viewing of a tool within the container. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Vasudeva and Ling to modify the storage container of Chen so the tool receiving member comprises an outline of the tool to be received in the tool receiving member and a mechanism in the base for enabling the base to be mounted on a vertical surface as taught by Vasudeva for better securing the tool in the tool receiving member and allowing the storage container to be mounted on a vertical surface during storage and/or use respectively and the opening includes a transparent window as taught by Ling to allow visual access to the tool within the container but preventing damaged to the tool from touching the tool.

7. Claims 4, 5 and 12 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Schurman (4,069,915) and Kirk (1,352,814). The tool storage container of Chen further fails to show a finger member being mounted on the base for maintaining the tool in the tool receiving member. Schurman shows a tool container (10) comprising a base having a tool receiving member for receiving a tool (12) and a finger member (50, 52) mounted adjacent the tool receiving member for maintaining the tool in the tool receiving member (Figures 1-2). Kirk teaches a container comprising a base (1) including a receiving member, a cover (2) pivotally coupled with the base and a finger member (39) mounted adjacent the receiving member. The finger member is movable between a first and a second position for maintaining an article (16) in the receiving member and enabling removal

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the article from the receiving member (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Schurman and Kirk to modify the storage container of Chen as modified so the base includes one or more fingers mounted on the base for maintaining the tool in the tool receiving member to prevent the tool from moving during shipping and handling.

8. Claims 10, 14 and 15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 8 above, and further in view of Lee (6,237,767). Chen further discloses the storage area in the cover includes a cover. Lee shows a tool box (10) comprising a base (11) and a cover (12) having at least one storage area (18) and each storage area comprises a cover (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Lee to modify the storage container of Chen as modified so the storage area in the cover includes a cover for better securing items within the storage area.

9. Claims 13-18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (6,237,767) in view of Chung (5,533,843), Schurman (4,069,915) and Kirk (1,352,814). Lee shows a tool storage container (10) comprising a base (11) including a tool receiving member defining an outline of the tool to be received and a cover (12) having at least one storage area (18) and each storage area including a cover (Figure 1). To the extent that Lee fails to show a power tool receiving member defining an outline of the power tool to be received, Chung teaches a power storage container comprising a base having a power tool receiving member defining an outline (112) of the power tool (3) to be received. It would have been obvious to one having ordinary skill in the art in view of Chung to modify the tool receiving member of Lee so it

comprises a power tool receiving member defining an outline of the power tool to be received for better securing the power tool. Lee also discloses the other claimed limitations except for a finger member being mounted adjacent the power tool receiving member. Schurman shows a tool container (10) comprising a base having a tool receiving member for receiving a tool (12) and a finger member (50, 52) mounted adjacent the tool receiving member for maintaining the tool in the tool receiving member (Figures 1-2). Kirk teaches a container comprising a base (1) including a receiving member, a cover (2) pivotally coupled with the base and a finger member (39) mounted adjacent the receiving member. The finger member is movable between a first and a second position for maintaining an article (16) in the receiving member and enabling removal the article from the receiving member (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Schurman and Kirk to modify the storage container of Lee so the base includes one or more fingers mounted adjacent the power tool receiving member for maintaining the power tool in the tool receiving member to prevent the power tool from moving during shipping and handling.

10. Claims 20, 21 and 25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (6,237,767) in view of Laszlo (5,366,071). Lee shows a tool storage container (10) comprising a base (11) including a tool receiving member defining an outline of the tool to be received and a cover (12) having at least one storage area (18) and each storage area including a cover (Figure 1). Lee fails to show the cover for covering the storage area being a pivotal cover. Laszlo shows a tool storage container (10) comprising a base (12) having a tool receiving member and a storage area (45-48) and a cover (18) pivotally coupled with the base. The cover

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including a storage area (30) having a pivotal cover (32) movable between a covering and non-covering position (Figures 1-2 and column 3, lines 60-68). It would have been obvious to one having ordinary skill in the art in view of Laszlo to modify the cover of the storage area of Lee so it comprises a pivotal cover movable between a covering and non-covering position for better opening and/or closing the storage area. As to claim 21, see Figure 4 of Lee.

11. Claims 23, 24 and 26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 20 above, and further in view of Schurman (4,069,915) and Kirk (1,352,814). The tool storage container of Lee further fails to show a finger member being mounted on the base for maintaining the tool in the tool receiving member. Schurman shows a tool container (10) comprising a base having a tool receiving member for receiving a tool (12) and a finger member (50, 52) mounted adjacent the tool receiving member for maintaining the tool in the tool receiving member (Figures 1-2). Kirk teaches a container comprising a base (1) including a receiving member, a cover (2) pivotally coupled with the base and a finger member (39) mounted adjacent the receiving member. The finger member is movable between a first and a second position for maintaining an article (16) in the receiving member and enabling removal the article from the receiving member (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Schurman and Kirk to modify the storage container of Lee so the base includes one or more fingers mounted on the base for maintaining the tool in the tool receiving member to prevent the tool from moving during shipping and handling.

12. Claims 27-29, 31 and 32 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Karay (949,485) in view of Perkins (4,303,158) and Fallon (4,768,652).

Karay discloses a storage container comprising a base (A) having at least one pocket/receiving member (h) and a cover (A') pivotally coupled with the base and having a storage ledge pivotally coupled with the cover. The storage ledge pivoting between a first position wherein the ledge is substantially parallel to the cover in a non-tool retaining position (Figure 7) to a second position wherein the ledge is substantially perpendicular to the cover (Figure 2) in a tool retaining position. To the extent that Karay fails to show tools pass through the ledge and being maintained perpendicular to the ledge in the tool retaining position, Perkins shows a tool box (11) including a storage ledge (37) having members (43) to allow tools pass through the ledge and the tools are maintained perpendicular to the ledge (Figure 3). Fallon teaches a tool case including a storage ledge (38) having members (60) to allow tools pass through the ledge and the tools are maintained perpendicular to the ledge (Figure 2). It would have been obvious to one having ordinary skill in the art in view of Perkins and Fallon to modify the ledge of Karay so the ledge includes members to allow tools pass through the ledge and maintained perpendicular to the ledge for better securing the tools on the ledge. As to claim 29, Karay further discloses a handle (722) and the handle is capable to be mounted on a vertical surface. As to claims 31 and 32, Karay also discloses the base having at least a second pocket/storage area and the cover including a pocket/storage area (h').

13. Claim 33 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 32 above, and further in view of Official Notice. Karay fails to

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show the storage area includes a cover. Official Notice is taken of the old and conventional practice for providing a container having a pocket/storage area and a flap/cover for covering the pocket for better securing items within the pocket. It would have been obvious to one having ordinary skill in the art in view of Official Notice to modify the storage container of Karay so the pocket includes a cover flap for covering the pocket for better securing items within the pocket.

Allowable Subject Matter

14. Claims 11, 19, 22, 30 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to all pending claims have been considered but are deemed to be moot in view of the new grounds of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to TC 3700 Customer Service at (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 872-9301. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb
November 13, 2003



Luan K. Bui
Primary Examiner